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EXAMINER				
RETTA, YEHDEGA				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/828,122

Applicant(s)

KATZ, GARY M.

Examiner

Yehdega Retta

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 11-19, 23, 27, 36, 44 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11-19, 23, 27, 36, 44 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is responsive to amendment filed March 12, 2009. Applicant amended claims 1-3, 11-19, 23, 27, 36, 44 and 48 and canceled claims 4-10, 20-22, 24-26, 28-35, 37-43, 45-47 and 49-64. Claims 1-3, 11-19, 23, 27, 36, 44 and 48 are pending.

Claim Objections

Claim 27 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The test for a proper dependent claim is whether the dependent claim includes every limitation of the parent claim. The test is not whether the claims differ in scope. A proper dependent claim shall not conceivably be infringed by anything, which would not also infringe the basic claim. If independent claim recites a method of making a specified product, a claim to the product set forth in the independent claim would not be a proper dependent claim since it is conceivable that the product claim can be infringed without infringing the base method claim if the product can be made by a method other than that recited in the base method claim. Therefore, claim 27 is improper dependent claims.

Claim 27 is not a ***proper independent claim*** since the claim incorporates all the limitations of an independent claim. Claim 27 dependent on claim 1. If Applicant asserts that the claim is independent claim than it should be written in independent form. Applicant may thereupon amend the claim to place it in proper dependent form, or may redraft it as independent claim, upon payment of any necessary additional fee.

The claim is still treated as improper dependent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 11-19, 23, 27, 36, 44 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 now recites “receiving, via at least one input device at a POS during a purchase transaction, said first consumer identification information, said first promotion, said second promotion, and product identifications of items of products being purchased: determining, with said at least one processor, during said purchase transaction, a promotion qualification indicating if a first product item associated with said first promotion and a second product item associated with said second promotion have been received via said at least one input device at said POS during said purchase transaction; and only if said promotion qualification indicates that both said first product item and said second product item were received via said at least one input device at said POS during said purchase transaction, with said at least one processor, deducting from a charge for said purchase transaction a value of promotion associated with said second promotion and a value of promotion associated with said first promotion”. However there is no support for this limitation in the specification. The specification teaches receiving promotion identification

information, using for example bar code reader, at a check-out counter (see [0034]). The specification also teaches a new record added to exercised promotion table 615 once the identity of both the promotion and the consumer is available to the processor and the record can include information such as price of the product for which the promotion is being exercised, the store where the promotion is being exercised, the value etc., and the information can be accessed to determine the relevancy of a promotion and/or to identify a more relevant promotion (see [0038]). The specification however does not disclose how the promotions are redeemed.

The specification also does not teach that “only if said first consumer first product category purchase determination indicates no prior purchase by said first consumer of either an item of said first product or of an item in said first product category, storing, with said at least one processor, in a database in a computer memory in association with said first consumer identification information, said first promotion”.

Claim 23 is also rejected for the same reason stated above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 11-19, 23, 27, 36, 44 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites storing product identification information indicating identification information of consumers associated with purchase of items of products by said consumers ... associated with identification of previous purchase of items of products by the that consumer.

First of all it is unclear what applicant meant by "storing, with at least one processor, in a database in a computer memory, product purchase history information, wherein said product purchase history information indicates identification information for consumers associated with purchase of items of products by said consumers, such that each identification information for each consumer is associated with identification of previous purchase of items of products by that consumer. Does the database stores consumer identification and also the consumer's purchases of products or just the identification of a consumer who happens to purchase products and/or who happens to purchase products previously? Second it unclear the difference between item and product. If item is different than a product it is not clear what item of a product is. It is also unclear what the difference is between an item of a first product and item of a first product category. The specification teaches product and product class or product category but does not teach item of a product.

Claim 23 is also rejected for the same reason stated above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 11-19, 23, 27, 36, 44 and 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Deaton et al. U.S. Patent No. 5,644,723.

Regarding claims 1-3, 11-19, 23, 27, 36, 44 and 48, Deaton teaches storing purchase history information for a customer, including previous purchase of items or products; determining if the purchase history information indicates prior purchases of product or product category; determining if consumer has not purchased a product (not purchased coffee or specific brand or coffee); determining a second promotion which has high relevance to the consumer based on relevance criteria, plurality of promotions and at least from the purchase history information (different brand of coffee or purchasing products other than the brand or coffee); outputting the first and second promotion; ("printing on a single sheet of paper a (printing coupon at a point-of-sale (1) first promotion for said consumer to purchase a product item (any transaction at the point-of sale) from that one of said first product category and said first product that said first determination indicates that said consumer has not purchased (e.g. coupon to shop at delicatessen or coupon for coffee or specific brand of coffee) in order to obtain a first reward (coupon (discount) for the purchase of item not been purchased and (2) a second promotion for said consumer to purchase a product item from that one of said second product category and said second product that said second determination indicates that said consumer has purchased in order to obtain a second reward" (more than one coupon is printed at the point-of-sale, which indicated that more than one reward (discount) is provided during a shopping (spooling selected coupon at the point of sale) (see col. 69 line 42 to col. 71 line 18).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 3, 23, 27, 36, 44 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Aggarwal et al. U.S. Patent No. 6,349,309.

Regarding claims 1, 23, 27, 36, 44 and 48 Aggarwal teaches receiving identification from a customer associated with identification of previous purchases (see col. 10 lines 65 to col. 11 lines 15); storing product purchase history; storing a plurality of promotions determining promotion relevance criteria; selecting promotion determined by more relevant based upon the identification information of previous purchases; paring (two or more) the low relevance and second relevance promotion (a list of recommended items in order of frequency of purchase) (see col. 11 lines 29-46); determining a purchase history of the consumer (col. 10 lines 65 to col. 11 lines 15); selecting a promotion determined to be more relevant based upon the purchase history; paring the low relevance and second relevance promotion; providing the paired promotion to customer; providing via an output device said first and second promotion to the consumer. Aggarwal teaches receiving promotional information regarding one promotion paring

promotions with low relevance promotions with other promotions providing the paired promotions to the customer. Aggarwal teaches providing promotional list (displayed together) sorted according to for example frequency of purchase reported to user in order of frequency of purchase, i.e., with lower frequency of purchase listed under the ones with higher frequency of purchase (see col. 11 lines 7-46).

Regarding claims 2 and 3, Aggarwal teaches purchase history including frequency of purchases in a product or a number of purchases in a product category (see col. 11 line 1-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal et al. U.S. Patent No. 6,349,309, and further in view of Herz et al. (US 6571279).

Regarding claims 11-19, Aggarwal teaches information about a customer's purchase behavior including a list of items purchased, the price of the items, the frequency of purchase and other information relating to an item for sale (see col. 11 lines 7-15). Since Aggarwal stores transaction history of every item purchased, whether the promotion is for goods from the same or different promoter, whether the product is new to the store or customer would not make a patentable difference to Aggarwal's promotional list. Those limitations are non-functional descriptive material. However, Herz teaches recording information about product's size, shape,

packaging and advertisement or anything that might impact its appeal to customers. Therefore, it would have been obvious to one ordinary skill in the art the time of the invention to include such information in order to provide shopper with coupons or promotions specifically tailored to their preference as taught by Herz (see col. 23 lines 1-67 and col. 24 lines 9-51).

Response to Arguments

Applicant's arguments with respect to claims 1-3, 11-19, 23, 27, 36, 44 and 48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The finality of the last Office action is withdrawn. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622